

REMARKS**I. Amendment to the Specification**

Applicants have added a new paragraph at the start of the specification to identify the relationship between this application and certain Government funding and to assert that the Government has certain rights in this invention. No new matter is added in this amendment.

II. Response to Pending Office Action

Claims 17-21 and 28 are currently pending in this Application. Claim 17 was amended in the response filed by Applicants on January 6, 2006. However, Applicants respectfully submit that the Examiner improperly based rejections on the original version of Claim 17 rather than the amended version submitted by Applicants resulting in the Examiner arguing elements that are not claimed.

Claims 29 and 30, which depend from entered Claim 28, were submitted in the response filed by Applicants on January 6, 2006. However, as discussed below, Applicants respectfully submit that the Examiner improperly refused to enter Claims 29 and 30.

Because the Examiner did not consider the amendment submitted by Applicants in the response submitted on January 6, 2006, and because the Examiner did not enter Claims 29 and 30 submitted in the response of January 6, 2006, Applicants respectfully request that the Examiner withdraw the pending Office Action and allow Claims 17-21 and 28-30.

Refusal to Enter Claims 29 and 30

The Examiner withdrew from consideration Claims 29 and 30 on the basis that Claims 29 and 30 are directed to non-elected species of the invention. Applicants respectfully traverse this withdrawal.

Claims 29 and 30 are dependent Claims ultimately depending from independent Claim 17 which is the broadest Claim of the elected species. Claim 29 depends from Claim 28 which depends from Claim 17. Because Claim 29 and 30 both depend from claims within the elected species, Claims 29 and 30 are, by definition, directed to the elected species.

The Examiner entered, and considered on the merits, Claim 28 conceding that Claim 28 is directed to the elected species. Claims 29 and 30 both depend from Claim 28 and therefore are also directed to the elected species.

Furthermore, it is respectfully submitted that the Examiner did not follow the requirements of MPEP §821 which clearly states "The examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention" (emphasis added). The Examiner has not clearly set forth the reasons why Claims 29 and 30 are not readable on the elected species.

Because Claims 29 and 30 both depend from Claims of the elected species and because the Examiner did not satisfy the requirements of MPEP §821, Applicants request that the Examiner enter Claims 29 and 30 and consider Claims 29 and 30 on the merits.

Claim Rejections under 35 U.S.C. §102

The Examiner rejected Claims 17, 21 and 28 under 35 U.S.C. §102(b) as being anticipated by Fraas et al. (US 5091018). Applicants respectfully traverse this rejection.

The Examiner rejected Claim 17 based on the claim wording prior to the Amendment submitted in Applicants' response filed January 6, 2006. In the pending Office Action, Examiner states that Fraas et al. discloses "...forming a surface coating (62, Fig. 8A) disposed over the substrate such that..." (emphasis added) (Office Action page 3). Claim 17 as amended in the January 6 response Claims "...forming a surface coating disposed over the first layer such that..." (emphasis added) (January 6 response page 3). Because the Examiner did not reject Claim 17 based upon the amended wording, the rejection is improper and Applicants request that the rejection be withdrawn.

Claims 21 and 28 both depend from Claim 17 and, because Claim 17 was improperly rejected, the rejection of Claims 21 and 28 should be withdrawn.

The Examiner has failed to sustain a case of anticipation. To sustain a rejection under USC §102(b), the Examiner must show that each and every element of the claim is present in the reference (See MPEP §3121). The Examiner has failed to make any assertion that the claimed element of "forming a surface coating disposed over the first layer" (as claimed in previously amended Claim 17) can be found in the reference or in any other source. Because the Examiner does not make any showing that every element of Claim 17 is present in the disclosure of Fraas et al. the Examiner has not supported this rejection and the rejection of Claim 17 should be withdrawn.

Claims 21 and 28 both depend from previously amended Claim 17 and, as such, include the element of "forming a surface coating disposed over the first layer" (see Claim 17 as amended in Applicants' January 6 response, page 3) which the Examiner has not shown is present in the cited reference. Therefore, the Examiner has not supported the rejection of Claims 21 and 28 and the rejection should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected Claims 18-20 under 35 U.S.C. §103(a) as being unpatentable over Fraas et al. (US 5091018) in view of Rittner (US 4135950). Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness. MPEP §2143 states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Dependent Claims 18-20 include the element of "forming a surface coating disposed over the first layer.." as set forth in independent Claim 17 (see January 6 response, page 3). The Examiner has made no showing or assertion that this element is taught or suggested by any reference. Because the Examiner has not shown that this element is present, the Examiner has not shown that the references teach or suggest all of the elements in Claims 18-20. Without such teaching or suggestion of the claim limitations there can be no motivation to combine or any expectation of success. Applicants respectfully submit, therefore, that the Examiner has not established a prima facie case of obviousness and the rejection of Claims 18-20 should be withdrawn.

With respect to Claim 19, in addition to the reasons above, Rittner does not teach or suggest removing texture from the back surface of the substrate. Rittner specifies that the back surface of the substrate is masked prior to etching to protect it from etching (col. 2, lines 18-21). The precise etching parameters are critical to Rittner's disclosure (col. 2, lines 56-59)., Rittner teaches one of skill in the art away from Applicants' etched back surface and subsequent removal of the etching from the back surface.

Conclusion

The Examiner rejected Claims 17-21 and 28 without considering elements added by amendment in Applicants' response filed January 6, 2006. The Examiner did not enter Claims 29 and 30 asserting, and without presenting any reasoning, that Claims 29 and 30 are directed to non-elected species, even though Claims 29 and 30 depend from entered Claim 28 and from the independent claim of the elected species (Claim 17).

Because the Examiner improperly rejected Claims 17-21 and 28 and because the Examiner improperly refused to enter Claims 29 and 30, Applicants request that the Examiner withdraw the pending Office Action and allow Claims 17-21 and 28-30.

Based on the above, Applicants respectfully request the Examiner to reconsider the outstanding rejections under 35 U.S.C. §§ 102(b) and 103(a). Applicants respectfully submit that Applicants have claimed patentable subject

matter, and Applicants request the Examiner to pass the instant patent application for allowance.

If the Examiner has any question regarding this paper, the Examiner is respectfully requested to contact Applicants' attorney, the undersigned, at the Examiner's convenience.

Correspondence Address:
BP America Inc.
Docket Clerk, Law Department, M.C. 5 East
4101 Winfield Road
Warrenville, Illinois 60555

Respectfully submitted,



Himanshu A. Vyas
Attorney for the Applicant(s)
Registration Number 52,331
(630) 821-2443